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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,004	09/16/2003	David H. Burkett	ACS 62622 (3714P)	3904
24201 7590 10/25/2007 FULWIDER PATTON LLP HOWARD HUGHES CENTER 6060 CENTER DRIVE, TENTH FLOOR LOS ANGELES, CA 90045			EXAMINER WACHTEL, EMILY L	
			ART UNIT 4111	PAPER NUMBER
			MAIL DATE 10/25/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/664,004

Applicant(s)

BURKETT ET AL.

Examiner

Emily Wachtel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-15 and 18-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 22 December 2003.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, claims 1-19; species D in set I (Figures 11 and 12); and species X in set II (Figure 19) in the reply filed on October 11, 2007 is acknowledged.
2. Claims 1-15 and 18-30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on October 11, 2007. Applicant elected claims 1-3, 6-7, and 10-17 as being readable on Group I, species D in set I, and species X in set II, withdrawing claims 4-5, 8-9, and 18-30. However, claim 1 recites an "uninterrupted polymer coating with a generally constant outside diameter adhering to at least a portion of the elongated core and *having a surface contour that follows the at least one of randomized and non-randomized tactile surface contours in the elongated core* (emphasis added)," the species elected in Figures 11 and 12 shows a smooth elongated core and the polymer coating having the at least one of randomized and non-randomized tactile surface contours, the surface contours are generated in the surface of the polymer coating only and do not originate from the surface texture of the underlying elongated core, as opposed to the contour being in the elongated core and being translated onto the coating as in claim 1. The limitation recited in claim 1 can be seen, for example, in species embodied by Figures 5 and 9. Therefore, claim 1, and its dependants, is drawn to a non-elected species. As a result claims 1-3, 6-7, and 10-15 are being further withdrawn as being drawn to a non-elected species.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: on page 12 for Figure 17 the guide wire is referred to with reference number 96 and this is not shown in the drawing. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: The reference number 32 appears in Figures 1 and 3 but it is not in the description. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

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be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because of the following informalities:

Page 6 line 17 --pitted-- should be --pits--

Page 10 lines 5 and 7 --68-- should be --64-- to correlate with the drawings

Page 16 line 12 --coatings-- should be --coating--

Appropriate correction is required.

6. The use of the trademarks TEFLON and MICROGLIDE have been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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8. Claims 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by McMahon (U.S. Patent 6,296,616 B1).

With regards to claim 16 McMahon teaches **an intraluminal guide wire** (Col. 2 lines 33-34), **comprising: an elongated core having a proximal core section and a distal core section including a taper transitioning to a distal end** (Fig. 1 ref. numbers 11, 12, and 13, Col. 2 lines 35-36 and 39); **wherein an exterior surface of the distal core section is substantially smooth** (Fig. 1 ref. number 13); **a polymer coating of generally non-uniform thickness adhering to at least a portion of the distal core section with a coating profile not following a tapered profile of the elongated core** (Fig. 1 ref. numbers 11, 13, 15 - sheath 15 is taken to be equivalent to a coating as Meriam-Webster dictionary defines a coat as 'a layer of one substance covering another' which is embodied by the sheath, and it does not follow the tapered profile of the elongated core, Col. 2 lines 45-46 - sheath is polymeric material), **the polymer coating having at least one of randomized and non-randomized tactile surface contours** (Fig 1 ref. numbers 15, 17, and 18); **and a flexible tubular member disposed over the distal core section** (Fig. 1 ref. number 14, Col. 2 lines 35-38).

With regards to claim 17 McMahon teaches **the intraluminal guide wire** (Col. 2 lines 33-34) **of claim 16, wherein the tactile surface contours includes a rib** (Fig. 1 ref. numbers 15, 17, and 18, Fig. 4 ref. numbers 33, 34, and 35 - 34 and 35 are contact and non contact regions which are circular ridges, these are taken to be ribs as Meriam-Webster dictionary defines a rib as 'an elongated ridge').

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Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. McMahon WO 9925413 A1 is an international publication of McMahon U.S. Patent 6,296,616 B1.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Wachtel whose telephone number is (571) 270-3648. The examiner can normally be reached on Monday through Thursday 7:30 AM to 5:00 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Yao can be reached on (571) 272-1224. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Emily Wachtel/
Examiner, Art Unit 4111



SAMCHUAN C. YAO
SUPERVISORY PATENT EXAMINER

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/E. W./ *EW*